

REMARKS/ARGUMENTS

Applicants have amended the claims to re-organize the structure and to clarify that the invention is directed to a brake release for a motor chain saw, particularly, a brake release adapted to illuminate forward and thus provide lighting for the saw chain of a chain saw. Brake releases for chain saws are well known in the art, but the addition of a light source secured within the brake release handle, rather than attached to the surface as in the prior art, has not previously been available. This difference is emphasized in the amended claim set. The new claim set is fully supported by the specification; see, *e.g.*, paragraph 28 on page 6.

Objection to Drawings

The Examiner objected to the drawings as not showing every feature of the invention. As amended, the claims do not recite the specific elements of a chain saw, but encompass only a brake release. The drawings show every feature of the brake release invention specified in the amended claims. Therefore, Applicants respectfully request reconsideration and withdrawal of the objection to the drawings.

Rejections under 35 U.S.C. Section 112

The Examiner rejected Claims 1-20 under 35 U.S.C. Section 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner asserts that the claims describe "considerable structure...that is other than the brake release." Applicants have cancelled Claims 1-40 and added Claims 41-55, which only

recite components of a brake release. In light of this amendment, Applicants request that the Examiner reconsider and withdraw this rejection.

The Examiner also rejected Claims 1-40 under 35 U.S.C. Section 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Examiner asks: "What type of brake, brake actuator, connection between the brake actuator and brake are being claimed? What do these parts look like and how are they to be assembled?" The Examiner also notes: "This missing structure appears to be more than what would be obvious to supply." Applicants respectfully traverse this rejection, as the invention does not contemplate changes to the way in which the brake release is attached to the chain saw or the way in which it functions as a brake. The novel improvement provided by this invention is securing a light within the brake release handle, as clarified in the new claim set. Further, the claims do not need to recite the structure and assembly of motor chain saws with braking devices to enable the invention, as such chain saws are well known in the art, as exemplified by U.S. Patent No. 4,683,660, to Schurr, which is cited in the present application. Therefore, Applicants respectfully request reconsideration and withdrawal of this rejection.

Rejections under 35 U.S.C. Section 103(a)

Casas in view of Cool – Claims 1-2, 9-22, 29-40

The Examiner rejected Claims 1-2, 9-22, and 29-40 under 35 U.S.C. Section 103 as obvious over Casas (U.S. Patent Publication No. 2002/0054491) in view of Cool (U.S. Patent No. 5,101,567). To establish a *prima facie* case of obviousness, the prior art

reference must teach or suggest all the claim limitations, there must be some motivation or suggestion to combine the references, and there must be a reasonable expectation of success. See MPEP § 2142, "Establishing a *prima facie* case of obviousness."

The claims, as amended, recite a brake release in which a light source is secured within the brake release handle. In contrast, Casas discloses a chain saw with a light attached to and extending prominently forward from the front of a brake release handle, as shown in Figure 2. Cool does not remedy the deficiencies of Casas, as it focuses on a brake release handle with a switch disposed *between* the safety guard and the brake lever. Cool does not disclose placing a switch or anything else *within* the brake release handle. Because Casas and Cool do not teach or suggest all of the claim limitations, they do not render obvious the claims, as amended. Moreover, neither reference provides motivation to modify the brake release handle so that a light source may be secured within the handle. Instead, Casas teaches away from such a modification by showing a separate and independent light source attached externally to a brake release handle. Because a *prima facie* case of obviousness has not been established, Applicants respectfully request that this rejection be reconsidered and withdrawn.

Casas in view of Cool in further view of Lin – Claims 3-8, 23-28

The Examiner also rejected Claim 3-8 and 23-28 under 35 U.S.C. Section 103 in light of Casas and Cool in further view of Lin (U.S. Patent No. 6,135,608). As noted above, neither Casas nor Cool, alone or combined, discloses each and every element of the claims, as amended. Lin describes placing a removable light assembly in a tool handle which is adapted at its front end to receive a tool element, such as a spanner tip, ratchet

socket, or tubular socket. None of these tools are analogous to a chain saw, and the handle in Lin is not a break release positioned as a break release handle is positioned in a chainsaw. The light of Lin can not shine forward onto the working areas, the tool itself precludes this. Lin provides no motivation to secure a light source to a chain saw, much less to a specific part of the chain saw, such as the brake release. Similarly, neither Cool nor Casas provides motivation to modify the brake release of a chain saw to include a light secured within the brake release handle. As noted above, Casas teaches away from such a modification. Because a *prima facie* case of obviousness has not been established, Applicant respectfully requests that this rejection be reconsidered and withdrawn.

In light of the above amendments and remarks, Applicants believe that each of the presently pending claims in this application is in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding objections and rejections to the claims and to pass this application to issue. Applicants do not believe that any fees are required by the claim amendments. However, if Applicants are mistaken, any required fees may be charged to deposit account 50-2767. If the Examiner has any questions regarding this communication, he is invited to contact the undersigned at (916) 444-3900, x274.

Respectfully submitted,

Dated: 14 September 2005

By: 

Carl J. Schwedler, Reg. No.: 36,924

McDonough Holland & Allen PC
555 Capitol Mall, 9th Floor
Sacramento, CA 95814-4692
Tel.: (916) 444-3900
Fax.: (916) 325-4587